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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,387	10/25/2005	Yoseph Shaaltiel	30570	1887

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EXAMINER

RAMIREZ, DELIA M

ART UNIT	PAPER NUMBER
1652	

MAIL DATE	DELIVERY MODE
04/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No. 10/554,387	Applicant(s) SHAALTIET ET AL.	
Examiner Delia M. Ramirez	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 February 2008.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 73-141 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 73-141 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

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DETAILED ACTION

Status of the Application

Claims 73-141 are pending.

It is noted that the examination of the instant application has been assigned to a different Examiner in Group Art Unit 1652.

Applicant's cancellation of claims 1-72 and addition of claims 73-141 as submitted in a communication filed on 2/22/2008 are acknowledged.

Applicant's election of Group II, claims 25-42, 67-69, directed to a recombinant high mannose protein and a pharmaceutical composition comprising said protein, is acknowledged. Applicant has indicated that new claims 98-113, 115-127, 114 and 128 correspond to now cancelled claims 25-42, 67-69.

Upon further consideration, the previous restriction requirement is hereby withdrawn. The instant Office Action is a supplemental restriction requirement. This supplemental requirement is at the discretion of the examiner (see MPEP 802 and 37 CFR 1.142) and is deemed appropriate and necessary in view of the plurality of claimed patentably distinct inventions.

It is noted that claims 135-137 are directed to a use, which is neither a method nor a product. For examination purposes, it will be assumed that these claims are directed to a method for manufacturing a medicament, wherein said medicament comprising the recited protein.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

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In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 75, 77, 79, 81-97, 129-134, drawn in part to a nucleic acid encoding a glucocerebrosidase and a method to recombinantly produce the glucocerebrosidase with the nucleic acid.

Group II, claim(s) 76, 78, 79-81, 85-97, 129-133, drawn in part to a nucleic acid encoding an alpha-galactosidase and a method to recombinantly produce the alpha-galactosidase with the nucleic acid..

Group III, claim(s) 99-102, 104-120, 122-128, drawn in part to a glucocerebrosidase and compositions thereof.

Group IV, claim(s) 99-101, 103-108, 110-118, 121-128, drawn in part to an alpha-galactosidase and compositions thereof.

Group V, claim(s) 135-137, drawn in part to a method for the manufacture of a medicament, wherein said medicament comprising a glucocerebrosidase.

Group VI, claim(s) 138-141, drawn in part to a method for treating a disease wherein said method requires administering a glucocerebrosidase.

2. The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

3. According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding special technical feature is a contribution over the prior art. The inventions listed as Groups I-VIII do not relate to a single general inventive concept because they lack the same or corresponding special technical feature. The technical feature linking all Groups is a human lysosomal protein which is shown by Martin et al. (DNA 7(2):99-106, 1988) and Garger et al. (U.S. Publication No.

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20020088024 published 7/4/2002) to lack novelty or inventive step since Martin et al. teach a human glucocerebrosidase, its coding polynucleotide, and a method to recombinantly produce the glucocerebrosidase, and Garger et al. also teach a human glucocerebrosidase produced in transgenic plants. Thus, the technical feature does not make a contribution over the prior art.

4. The polynucleotides of Groups I-II do not have unity of invention with the methods of Groups V-VI according to 37 CFR 1.475(b)(c) since the methods of Groups V-VI are methods of use of the protein of Group III.

5. The protein of Group III and the methods of Groups V-VI while being a combination comprising a product and a process of use of said product, do not have unity of invention according to 37 CFR 1.475(b) since Group I (main invention) already contains one of the combinations set forth in 37 CFR 1.475(b), i.e., a product and a process of use of said product, and the combinations of Groups III/V or Group III/VI are an additional combinations as set forth in 37 CFR 1.475(b)(2).

6. Claims 73-74 link(s) inventions I-II, and claim 98 links inventions III-IV. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 73-74, 98. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 Claims that require all the limitations of an allowable linking claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant

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application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

7. The Examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

8. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

9. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If

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the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally

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be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Nashaat Nashed can be reached on (571) 272-0934. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

/Delia M. Ramirez/

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
April 4, 2008